

REMARKS

Applicants respectfully request entry of the above amendments, and consideration of the application as amended.

By the above amendment Applicants have amended claims 1, 7, 10, 12, 13, 14, 29, 54, and 56 and introduced new claims 65-69. Applicants also cancelled claims 44 and 46. No new matter was introduced.

Claims 1, 3, 4, 7, 9, 10, 12-14, 23-25, 29-39, 50, 51, and 54-69 are now pending in this application.

The Applicant acknowledges with appreciation the Patent Office's withdrawal of the claim objections and 35 U.S.C. §112 rejections.

The Applicant also acknowledges with appreciation the thoroughness of the Patent Office's comments. The annotated figures from the cited references were especially helpful. Thank you.

1. Response to Anticipation Rejection based upon the German Patent

In paragraphs 4 and 5 on pages 2 and 3 of the Office Action, the Patent Office rejected claims 1, 3, 4, 7, 9, 10, 12-14, 44, 46, 50, 51, and 53-64 under 35 USC §102(b) as anticipated by German Patent DE 2127913 [herein "the German Patent"]. However, Applicants submit that the above amendment of claim 1 overcomes these rejections.

The conditions for which an anticipation rejection is appropriate as defined in MPEP § 2131 were outlined in Applicants' earlier response dated July 29, 2005 (the disclosure of which is incorporated by reference herein in its entirety) and, though applicable to this rejection, are not repeated here for the sake of brevity.

Applicants submit that the German Patent does not include "each and every element" of the invention recited in amended claim 1, nor does the German Patent show the invention "in as complete detail" as in claim 1.

Among other things, claim 1 has been amended to recite that both the first ornament and the second ornament in the claimed arrangement have "at most a first aperture and a second aperture" [Emphasis added.] This aspect of the present invention is illustrated throughout the instant specification and drawings, for example, as shown in Figures 26 and 27.

In contrast, the ornament arrangement of the German Patent, for example, Figures 9, 10, and 11 of the German Patent, when connected by two connectors, all have more than two apertures. That is, there are no ornaments disclosed in the German Patent having only two apertures that share two common connectors. The Applicant submits that amended claim 1 is not anticipated by the German Patent.

Moreover, the Applicant submits that there is no motivation or suggestion in the German Patent to provide the arrangement as recited in amended claim 1. Specifically, due to the nature of the ornament arrangements shown in Figures 9-11 of the German Patent, having only two apertures in each ornament, and employing the "cross" connectors shown in the German Patent, would permit the connection of only two ornaments. That is, a chain of three or more ornaments would not be possible if the ornaments of the German Patent had at most two apertures as claimed. Specifically, if two of the connectors disclosed in the German Patent were used to connect two ornaments each having only two holes, the two connectors would occupy all the available holes in the two ornaments and no further holes would be available for attaching further connectors and further ornaments. Furthermore, the ornament chain having only two ornaments and the "cross" connectors shown in the German Patent would be unsightly, due to the exposed unattached tines of the connectors. Thus, the Applicant submits that of the invention recited in claim 1 is also not obvious in view of the teachings of the German Patent.

With respect to the rejections of dependent claims 2-5, 9, 10, 12-14, 44-46, 50, and 51, Applicants submit that these claims are not anticipated by the German Patent for the same reasons that claim 1, from which they depend, is not anticipated. New dependent claims 64 and 65, dependent upon claim 50, further define inventions having single row of ornaments that further distinguishes the claimed invention from the German Patent. The Applicant submits that the German Patent does not disclose or suggest the single-row ornament chain recited in, for example, claims 64 and 65. Applicants respectfully submit that these rejections be reconsidered and withdrawn.

2. Response to Anticipation Rejection based upon the EP Patent

In paragraph 6 on pages 6-8 of the Office Action, the Patent Office rejected claims 23-25 and 54-59 under 35 USC §102(b) as anticipated by EP Patent Application 0200924 [herein "the EP Application"]. However, Applicants respectfully submit that these rejections are also inappropriate. Applicants submit that the EP Application does not include "each and every element" of the invention recited in these claims, nor does the EP Application show the invention "in as complete detail" as these claims.

With respect to the rejection of claim 23, the Patent Office bases its rejection on Figure 10 of the EP Application. The Applicant submits that though Figure 10 appears to display "at least one ornament having a first aperture and a second aperture"; however, there the similarity to the claimed invention ends. The Applicant draws the Patent Office's attention to Figures 30-36 and 52 of the instant application for an illustration of the aspect of the invention recited in claim 23. The Patent Office identifies the "crosspiece" 8 of the Figure 10 of the EP Application as the claimed hook and the "freely protruding ends" 105 of "rods" 5 as the first end and the second end of the hook which are adapted to be "inserted into and secured to" the aperture of ornament 6. However, the Applicant respectfully submits that crosspiece 8 and rod ends 105 do not correspond to the invention recited in claim 1.

First, according to the EP Application (for example, the first paragraph on page 10 and the subsequent paragraph bridging pages 10 and 11 of the EP Application), crosspiece 8 is in no way intended to function as a hook of any kind. As clearly disclosed in the EP Application, the structure shown in Figure 10 is not suspended from crosspiece 8, but the rod ends 105 are inserted into holes in an upper and a lower ring. This mounting arrangement is clearly shown in Figure 2 of the EP Application where rod ends 105 engage upper ring 1 and lower ring 2. The Applicant submits that crosspiece 8 does not correspond to the claimed hook of the claim 23, for example, hook 140 shown in Figure 34 of the instant application, and crosspiece 8 is not adapted to be hung from a support of any kind.

Second, the rod ends 105 associated by the Patent Office with the first and second ends of the hook are clearly not part of cross piece 8 and clearly do not engage ornament 6 of the EP Application. Rod ends 105 are ends of rods 5 and not ends of crosspiece 8. Moreover, ends 105 do not engage ornament 6 in any way, they are "freely protruding ends" as recited in the EP application to engage the support rings 1 and 2.

Thus, the Applicant submits that the EP application does not anticipate the invention recited in claim 23. The Applicant respectfully requests that this rejection be reconsidered and withdrawn.

With respect to the rejections of dependent claims 24, 25, the Applicants submit that these claims are not anticipated by the EP Application for the same reasons that claim 23, from which they depend, is not anticipated. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

With respect to the anticipation rejection of claim 54, the Patent Office again refers to the structures shown in Figure 10 of the EP Application. The Applicant contrasts the EP Application with the aspect of the invention shown in Figure 53 of the instant application. The Patent Office identified rod 5 as the claimed "continuous

connector" passing through the apertures of the ornament. The Applicant submits that the above-amended claim 54 clearly distinguishes the recited invention from that which is disclosed in the EP application. Specifically, claim 54 was amended to recite that the claimed continuous connector comprise "means to engage and secure" the at least three ornaments "in spaced relationship with each other." As shown in Figure 10 of the EP Application, the ornaments shown are not engaged and secured by rods 5, but engaged and positioned by beads 13 on rods 5. This aspect of the invention is an improvement on prior art such as that shown in Figure 10 of the EP Application by precluding the need for additional hardware or positioning means such as beads 13. The Applicant submits that amended claim 54 is not anticipated by the EP Application and requests that this rejection be reconsidered and withdrawn.

With respect to the rejections of dependent claims 55-59, the Applicants submits that these claims are not anticipated by the EP Application for the same reasons that claim 54, from which they depend, is not anticipated. Moreover, new dependent claims 68 and 69 further distinguish from the EP Application. New claim 68 recites that the means to engage and secure the ornaments "consists of deformations" in the continuous connector. That is deformations in the connector and only deformations in the connector, and not beads or other restraining means. Claim 69 recites that the deformations comprise elongated loops, for example, as shown in Figure 53 of the instant application. The Applicant submits that neither of these limitations are disclosed or suggested by the EP Application. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

3. Response to Anticipation Rejection based upon Schonbek

In the second paragraph 6 on pages 9-11 of the Office Action, the Patent Office rejected claims 29-38 and 60-62 under 35 USC §102(b) as anticipated by U.S. Patent 5,144,541 of Schonbek [herein "Schonbek"]. However, Applicants respectfully submit that these rejections are also inappropriate. Applicants submit that Schonbek does not

include "each and every element" of the invention recited in these claims, nor does Schonbek show the invention "in as complete detail" as these claims.

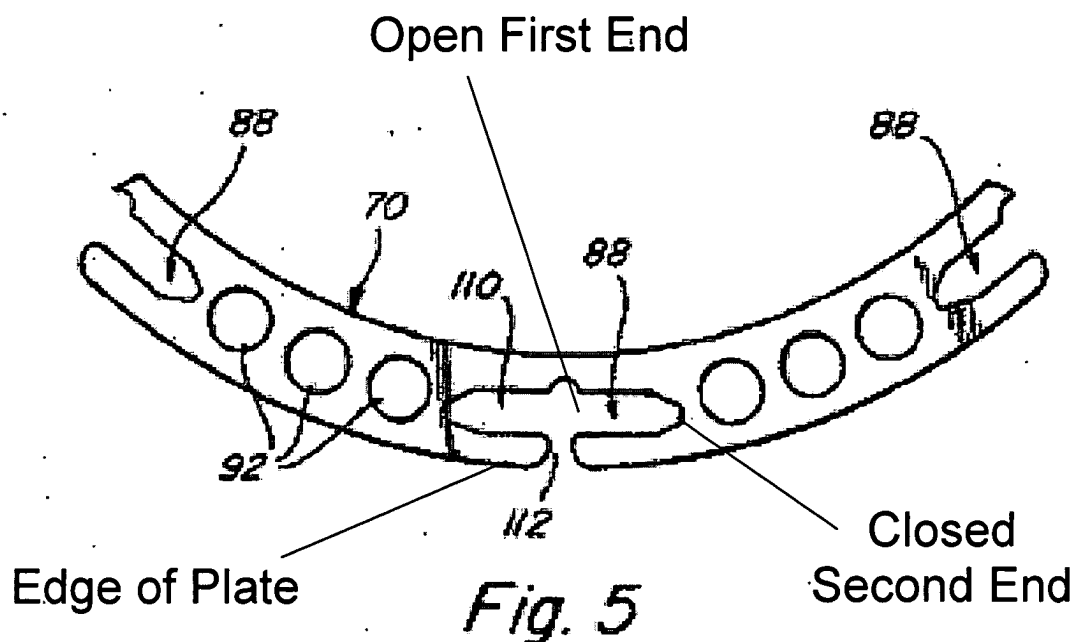
The Patent Office is advised that the Assignee of the Schonbek patent is the same as the assignee of the present application. In fact one of the co-inventors of the present application, Andrew J. Schonbek, is the son of the sole inventor that appears on Schonbek, Arnold Schonbek. Clearly, the Applicant is familiar with the art of Schonbek and its distinctions from the present invention recited in claim 29 and its dependents.

The Applicant is dismayed by the apparent lack of thoughtful consideration of the Applicant's remarks that appear in the previous response to the rejection of the same claims based upon the same prior art.

With respect to the rejection of claim 29, the Applicant submits that the aspect of the invention recited in claim 29 is most clearly illustrated in Figure 52 of the instant application, though Figures 43-51 also illustrate related features. The Applicant submits that Schonbek does not anticipate the invention recited in claim 29.

The Patent Office claims that the structures shown in Figure 5 of Schonbek anticipate claim 29. The Patent Office identifies the plate 70 and opening 88 of Figure 5 in particular. In the previous Action, the Patent Office rejected claim 29 and its dependents as anticipated by the structure in Figure 9 of Schonbek. The Applicant appears to have effectively overcome this rejection based upon Figure 9 since no reference to Figure 9 appears in the latest Action. The Applicant is however dismayed that, apparently, the Patent Office believes that by simply referring to a different figure of Schonbek, regardless of the inappropriateness of the rejection, that Schonbek somehow anticipates the invention recited in claim 29. However, the Applicant submits that Figure 5 of Schonbek also fails to teach or suggest the claimed invention for the same reasons Figure 9 of Schonbek failed to teach or suggest the claimed invention.

With respect to Figure 5 of Schonbek, contrary to the claimed invention, the opening 88 in ring 70 does not correspond to the claimed channel having a first open end located at the end of the plate and second closed end. Even if opening 88 is considered a "channel" claim 29 is not anticipated. If opening 88 is a channel, then as shown in marked up of Figure 5 below, channel 88 may include a first open end and a second closed end. However, the first open end of opening 88 is not located at the edge of the plate as claimed. As shown in the attached mark up of Figure 5, the open end of opening 88 is internal to plate 70, not open to the edge of plate 70. In order to emphasize this distinction, the Applicant has amended claim 29 to recite that the claimed edge of the plate is an "outer edge." For this reason alone, the Applicant submits that this rejection of claim 29 is inappropriate.



Further, if opening 88 is considered a channel having a first open end and a second closed end, opening 88 does not include a horizontal passage and at least one vertical passage between the open first opened end and closed second closed end as

claimed. As shown in the mark-up of Figure 5, if the Patent Office defines opening 88 as having first open end and a second closed end, there is only one horizontal passage, there is no vertical passage between the open first end and closed second end as claimed. Again, the Applicant submits that Schonbek does not anticipate claim 29.

Moreover, contrary to the statements made by the Patent Office, the opening 88 in plate 70 of Schonbek, which the Patent Office identifies as the claimed "channel," are not "adapted to receive the hook of the ornament and support the hook in the closed second end of the channel" as claimed. This is the same limitation lacking in the opening 142 of Figure 9 of the previous Action. The Patent Office's comments suggest opening 88 receives a hook. However, again, examination of Figure 6 of Schonbek, which illustrates a view of an assembled fixture having gallery ring 70, clearly indicates that opening 88 receives octagonal crystal 76, but opening 88 does not receive any hooks of any kind. In fact, opening 88 is provided with a shape that is specially designed to receive an octagonal crystal, not a hook. The details of the acceptance of crystal 76 in aperture 88 are illustrated in Figures 7A, 7B, 7C, and 8 of Schonbek. As clearly shown in these figures, contrary to the comments made by the Patent Office, aperture 88 does not receiver or engage hook 82, aperture 88 receives ornament 76. The Patent Office's interpretation may be due to a misconnection of what is shown in Figure 8 of Schonbek. As clearly described in 3:23-26 of Schonbek, Figure 8 illustrates the act of installing a chain 72 onto ring 70 which results in the installed arrangement shown in Figure 7C. Again, the aperture 88 receives the ornament 76 not the hook 82. As shown in Figures 9-11, the only aperture of Schonbek that receives a hook in the unnumbered circular apertures in ring 140, which has nothing to do with the present invention. Thus, Applicants submit that Schonbek does not anticipate the inventions recited in claim 29. The Applicant requests that this rejection be reconsidered and withdrawn.

With respect to the rejections of dependent claims 30-36, 60 and 61, the Applicant submits that these claims are not anticipated by Schonbek for the same

reasons that claim 29, from which they depend, is not anticipated. In addition several limitations of these dependent claims are also clearly not taught or suggested by Schonbek. For example, with respect to claim 34, the opening 88 of Figure 5 does not include "at least two vertical passages" as claimed. Contrary to what the Patent Office appears to imply, openings 88 and 110 of Schonbek are not between the open first end of opening 88 and the closed end of opening 88. With respect to claims 35 and 36, as noted above, the only mounting hook that engages a plate is shown in Figures 9-11 and these hooks do not engage opening 88 in Figure 5. With respect to claims 60 and 61 plate 70 in Figure 5 of Schonbek is a clearly a horizontally oriented plate, not a vertically oriented plate as claimed. See Figure 6 for the as-installed orientation of plate 70 of Schonbek. With respect to claim 62, since aperture 88 does not receive a mounting hook, aperture 88 inherently cannot be adapted to obstruct disengagement of a mounting hook, as suggested by the Patent Office. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

With respect to the rejection of claim 37 in view of Schonbek, the same comments with respect to the rejection of claim 29 apply to the rejection of claim 37. Again, as discussed above, connector 82 of Figure 8 is not only not a mounting hook, but connector 82 is not received by plate 70. As shown in Figures 7A-7C, ornament 72 engages plate 70. Also as discussed above, channel 88 does not have a first open end at the edge of the plate and does not include both a horizontal and a vertical passage. The Applicants submit that Schonbek does not anticipate the invention recited in claim 37. The Applicant requests that this rejection be reconsidered and withdrawn.

With respect to the rejections of dependent claim 38, the Applicant submits that this claim is not anticipated by Schonbek for the same reasons that claim 37, from which it depends, is not anticipated. The Applicant respectfully requests that this rejection be reconsidered and withdrawn.

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Reply to Office Action of October 4, 2005

4. Allowable Subject Matter


In paragraph 8 on page 11 of the Office Action, the Patent Office identifies the subject matter recited in claim 39 as allowable if rewritten in independent form. The Applicant recognizes with appreciation the acknowledgment of the allowability of this subject matter. However, as discussed above, Applicants believe that the Applicant is entitled to further protection in view of the prior art cited in the Office Action.

5. Conclusion

An early and favorable action on the merits of this application is requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned Agent invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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